

App. No. 09/483,537

REMARKS/ARGUMENTS

Rejection of Claims 1 – 4 and 6 Under 35 U.S.C. §102(b)

Claims 1 – 4 and 6 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kemp, "Discover Debuts Its First Platinum Card." Claims 1 – 4, and 6 have been cancelled without prejudice.

Amendment to Add New Claims 21 - 50

Applicant has added new claims 21 – 50 to more clearly define the present invention. With regard to the disclosure of Kemp, the Applicant respectfully asserts that the Examiner has failed to provide a reference that anticipates every element of the newly claimed invention in the present application. At a minimum, Kemp fails to disclose tax refund payments or other types of payments from governmental entities as described in independent claims 21, 27, and 33 of the present application. At least in this respect, the present invention described in independent claims 21, 27, and 33 of the present application is distinguished over the Kemp reference.

In addition, Kemp is non-enabling with respect to describing any means or method of procurement of the spending vehicles as alleged by the Examiner. The Applicant respectfully asserts that the Examiner has failed to provide a reference that anticipates the claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131. In this regard, the Applicant respectfully states that the Examiner's reference does not expressly set forth every element of the claimed present invention. For

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example, Kemp does not disclose an "indirect assignment of payment rights" as described by the Examiner in the present Office Action. The Kemp reference does not provide any teaching wherein Discover Financial Services, Inc. provides an assignment to one of the Platinum Partners.

Although the Examiner has not extended the use of Kemp into the structure of an obviousness rejection of the claims of the present invention, the Applicant is aware that the Examiner is permitted "[I]n considering the disclosure of a reference, ... to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda* 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) MPEP §2144.01. However, the Applicant is not clear as to how the Examiner may read an inference of an "indirect assignment of payment rights" from Kemp as alleged by the Examiner. The Applicant respectfully points out that Kemp does not specify the manner in which Discover Financial Services, Inc. will procure the gift certificates.

In this respect, the Applicant respectfully speculates that the Examiner's allegation of the Kemp reference disclosing "an indirect assignment of payment rights" may be based upon common knowledge in the art or based upon facts within the personal knowledge of the Examiner. The Applicant respectfully asserts that an indirect assignment of payment rights would not be based upon common knowledge in the art. For example, the certificates could be issued by Discover Financial Services, Inc. strictly as a promotional vehicle for a Platinum Partner that does not require an assignment. The Applicant is unable to determine the means of procurement of the certificates in Kemp because the Examiner's reference does not disclose it amongst the variety of business-related motivations for attracting customers and

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conducting business. As a result, the Applicant respectfully contends that Kemp cannot be construed to anticipate the claimed present invention.

In addition, if "an indirect assignment of payment rights" is based upon facts within the personal knowledge of the Examiner, then the Applicant respectfully requests that the Examiner provide an affidavit regarding that knowledge in accordance with 37 C.F.R §1.104(d)(2) to support such a ground for rejection.

In view of the foregoing, the Applicant respectfully submits that the Examiner's rejection may be properly withdrawn for the failure of the prior art to teach or suggest each claim limitation in the claims of the present application.

CONCLUSION

Claims 1 – 4, and 6 have been cancelled without prejudice. New claims 21 – 50 have been amended to the present application by this response to the present Office Action. The Applicant has distinguished the present invention from the prior art reference cited by the Examiner.

In light of the foregoing remarks, the Applicant respectfully submits that the present application is now in condition for allowance, and such action is earnestly requested.

Respectfully submitted,

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